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MCI, INC
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OFFICE OF PETITIONS

In re Application of
B. Reilly Barry et al.
Application No. 09/159,503
Filed: September 24, 1998
Attorney Docket No. COS-97-101

ON PETITION

This is a decision on the petition filed July 29, 2004, under 37 CFR § 1.48 and 37 CFR § 1.47. The petition seeks to correct the inventorship of the above-identified application and accord status under 37 CFR 1.47 in the absence of the signatures of all the named inventors.

The petition under 37 CFR § 1.48 is **DISMISSED**.
The petition under 37 CFR § 1.47 is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. **FAILURE TO TIMELY RENEW THE PETITION WILL RESULT IN ABANDONMENT.** The reconsideration request should include a cover letter entitled "Renewed Petitions under 37 CFR §§ 1.48 and 1.47.

The application was filed naming B. Reilly Barry, Mark A. Chodoronek, Eric DeRose, Mark N. Gozales, Angela R. James, Lynne Levy and Michael Tusa as joint inventors. It was later learned that Carol Y. Devine was also a co-inventor and petitioner seeks under 37 CFR § 1.48(a) to amend the inventive entity by the addition of Carol Y. Devine. 37 CFR § 1.48(a) requires that an amendment to the named inventive entity be accompanied by:

- (1) a petition including a statement from *each person being added* and from each person being deleted as an inventor that the error occurred without deceptive intention on his or her part;
- (2) an oath or declaration by each actual inventor or inventors as required by 37 CFR 1.63 or as permitted by 37 CFR 1.42, 1.43 or 1.47;
- (3) the fee set forth in 37 CFR 1.17 (I); and
- (4) the written consent of any existing assignee, if any of the originally named inventors has executed an assignment.

Petitioners have submitted a statement of lack of deceptive intent executed by Ms. Devine and an assent of assignee to correction and/or addition of inventor, however, the supplemental oath or declaration has not been executed by joint inventors DeRose and Levy. Petitioners argue that joint inventors DeRose and Levy "appear either unwilling or unable to cooperate with the furthering prosecution of the above-identified application". In lieu of a declaration executed by joint inventors DeRose and Levy, petitioners seek status under 37 CFR § 1.47(a).

A grantable petition under 37 CFR § 1.47(a) requires:

- (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);
- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;
- (3) the petition fee; and
- (4) a statement of the last known address of the non-signing inventor.

As to the requirements of 37 CFR § 1.47(a), the petition fails for lack of compliance with item (1) and thus, the petition under 37 CFR § 1.487(a) fails for lack of compliance with item (2).

Petitioners claim that a copy of the application was sent via FEDEX to Mr. DeRose on March 2, 2004. It appears that Mr. DeRose no longer lives at the last known address and as such, the package containing the application was returned as undeliverable. There is no issue concerning the package forwarded to Ms. Levy as it shown that the package was mailed to the last known address and undeliverable. It is assumed that with respect to Ms. Levy, that the address was correct but that the delivery of the package was just refused. If this is incorrect, petitioner should apprise the Office of the facts surrounding the package to Ms. Levy immediately.

The evidence presented however, is not sufficient to show that Mr. DeRose either cannot be located or that he refuses to cooperate with the filing of the application. The proof submitted does not show that diligent efforts have been employed to forward a complete copy of the application papers to Mr. DeRose and in the absence of that, it hasn't been shown that he is refusing to cooperate.

If petitioners are satisfied that Mr. DeRose no longer lives at the last known address and would like to argue that he cannot be located, petitioners must present a showing that diligent efforts have been made to locate him.¹ Petitioners must however provide details, in an affidavit or declaration of facts by a person with first hand knowledge of

¹MPEP 409.03(d).

the details, of the additional efforts to locate Mr. DeRose such as Internet, e-mail, or telephone directory searches, which have been undertaken to locate him. If repeated attempts to contact Mr. DeRose by telephone, mail, and e-mail, are unsuccessful, petitioners will have established that he cannot be found despite diligent efforts. If an address for the non-signing inventor is located, petitioner will want to show proof that a copy of the application was sent or given to the non-signing inventors for review by providing a copy of the cover letter transmitting the application papers to the non-signing inventors or details given in an affidavit or declaration of facts by a person having first hand knowledge of the details.

Likewise, before a *bona fide* refusal can be shown, the non-signing inventor must have been given an opportunity to review the application. Therefore, petitioners must show proof that the non-signing inventor refuses to sign the declaration after being sent or given a copy of the application papers. If there is a written refusal, petitioners should submit a copy of that refusal with any renewed petition. If the refusal was made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of facts.

Because the proof submitted is insufficient to accord status under 37 CFR § 1.47(a), the petition under 37 CFR § 1.48 is also deficient.

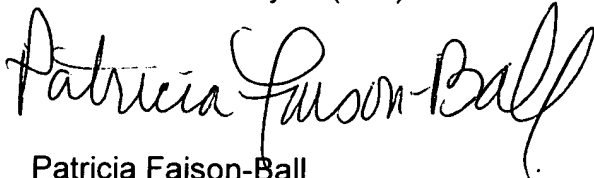
The petition fee for the petition under 37 CFR § 1.47(a) was charged to the deposit account upon filing. Additionally, a fee in the amount of \$130.00 has also been charged to deposit account no. 13-2491 as authorized in the petition for the petition under 37 CFR § 1.48.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petitions
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (703) 872-9306
 Office of Petitions

Telephone inquiries concerning this matter may be directed to the undersigned Petitions Attorney at (571) 272-3212.

A handwritten signature in cursive script, reading "Patricia Faison-Ball". The signature is written in dark ink and is positioned above the printed name and title.

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions